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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,055	06/06/2001	Yoko Iwamiya	208853US0	5631

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EXAMINER

METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s) N .

09/874,055

Applicant(s)

IWAMIYA ET AL.

Examiner

Daniel S. Metzmaier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/3/2001 & 2/28/2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-13 are pending.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The corrected or substitute drawings were received on October 3, 2001, Paper No. 4. These drawings are Acceptable for examination.

Information Disclosure Statement

3. The related application, 09/572,652, corresponds to US 6,403,183. said reference has been considered.

Specification

4. The abstract of the disclosure is objected to because said abstract is not in single paragraph format. Correction is required. See MPEP § 608.01(b).

Claim Objections

5. Claims 1, 5-8 and 11-13 are objected to because of the following informalities: the claims are not drafted in proper sentence format and each of the noted claims has either two periods or does not end in a period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants employ parenthetically bound limitations, which it is unclear whether said limitations are part of the claim or a preferred embodiment. See claims 1, 5-8 and 11-13 as examples.

Page 12 In claims 1 and 8, the value of "n" is undefined. It is unclear what is the scope of the claimed subject matter.

In claim 1, "the formula 1" lacks proper antecedent basis. See also claims 5-8 and 11-13. In claim 8, "the above formula 1" lacks proper antecedent basis.

The claims are unclear where the claims set forth the R groups as an oligomer comprising a siloxane bond. It is unclear what the remaining structure of the siloxane, which has not been set forth includes. Claim 5, 6, 7, 11-13

The language, "mainly comprising" renders the claims indefinite since it is unclear what is the scope of said claim. Said language has been interpreted as having the same meaning as "comprising".

Furthermore, "the above main component" lacks proper antecedent basis throughout the claims.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

9. Claims 1-4 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Marwitz et al, US 3,671,485. Marwitz et al (examples) discloses coating compositions and articles comprising silanes reading on formula 1 when $n = 1$ and employing a tin catalyst.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim Rejections - 35 USC § 103

11. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marwitz et al, US 3,671,485. Marwitz et al discloses coating compositions and articles for fiber materials.

Marwitz et al differs from the claims in the exemplified use of an alkenyl substituted silane.

Marwitz et al (column 1, lines 72 et seq) teaches the use of alkyl or alkenyl substituted silanes as the second component.

It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the alkyl and/or alkenyl substituted silanes for treatment of the fiber materials and/or paper food packaging as a art recognized silane for treating said substrates taught in the Marwitz et al reference.

12. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kazari-Ichi Co, Ltd., EP 1 059 383 A1, in view of Marwitz et al, US 3,671,485. Kazari-Ichi Co, Ltd (abstract, examples, [0001], [0042] and claims) discloses coated material and coating solutions as claimed. The reference clearly contemplates fibers as set forth in [0001].

Marwitz et al (column 1, lines 1 et seq) discloses silane based coatings for treating paper and films among other substrates for food packaging. Marwitz et al (column 4, lines 7-20) teaches a number of materials to be treated include paper, fibers, foil sheet, wood and organic plastics.

These references are combinable because they teach treatment of food packaging with silane based compositions and Marwitz et al is cited on the 6,403,183 as prior art. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the compositions of Kazari-Ichi Co, Ltd for treatment of the fiber and paper food packaging as an prior art recognized substrate used in food packaging.

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13. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being obvious over Iwamiya et al, US 6,403,183, in view of Marwitz et al, US 3,671,485. Please see (abstract, examples, column 8, lines 53-58; and claims) discloses coated material and coating solutions as claimed. The reference clearly contemplates fibers as set forth in the abstract.

Marwitz et al (column 1, lines 1 et seq) discloses silane based coatings for treating paper and films among other substrates for food packaging. Marwitz et al (column 4, lines 7-20) teaches a number of materials to be treated include paper, fibers, foil sheet, wood and organic plastics.

These references are combinable because they teach treatment of food packaging with silane based compositions and Marwitz et al is cited on the 6,403,183 as prior art. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the compositions of Iwamiya et al for treatment of the fiber and paper food packaging as an prior art recognized substrate used in food packaging.

The applied reference has a common Inventor and is currently commonly assigned with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject

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matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

14. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamiya et al, US 6,403,183, in view of Marwitz et al, US 3,671,485. Said reference qualifies as art under 102(f). Please see (abstract, examples, column 8, lines 53-58; and claims) discloses coated material and coating solutions as claimed. The record does not show the inventions commonly assigned or under obligation of assignment at the time of invention. The reference clearly contemplates fibers as set forth in the abstract. Please see the preceding rejection under 35 USC 103(a) wherein the reference qualifies as prior art under 35 USC 102(e).

15. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over ENSO OY, WO 98/22654. ENSO OY (page 4, lines 1 et seq) discloses treating paper fiber material with a silane compositions. ENSO OY (page 6 et seq) teaches suitable silanes including silanes corresponding to the claimed structures.

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ENSO OY (page 8, lines 6-14) teaches the curing catalyst. ENSO OY (page 8, lines 20 et seq) further teaches alcohols.

ENSO OY differs from the claims in an exemplified combination of the alkylsilanes, multisubstituted silanes and the hydrolysable organometallic in the exemplified compositions.

It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ the silanes taught in the ENSO OY reference for their function of creating a polymeric coating for the food package art. It is generally *prima facie* obvious to use in combination two or more ingredients that have previously been used separately for the same purpose in order to form a third composition useful for that same purpose. The idea of combining them flows logically from their having been individually taught in the prior art.

Double Patenting

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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17. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 13-15 of U.S. Patent No. 6,403,183 in view of Marwitz et al, US 3,671,485. Although the conflicting claims are not identical, they are not patentably distinct from each other because said claims differ in the substrate treated and the prior art recognizes the treatment of said substrates interchangeably for the food packaging art.

6,403,183 discloses and claims (claims) a transparent article comprising a cellophane substrate coated on at least one surface with the instantly claimed coating compositions. 6,403,183 differs in the substrate being coated.

Marwitz et al (column 1, lines 1 et seq) discloses silane based coatings for treating paper and films among other substrates for food packaging. Marwitz et al (column 4, lines 7-20) teaches a number of materials to be treated include paper, fibers, foil sheet, wood and organic plastics.

These references are combinable because they teach treatment of food packaging with silane based compositions and Marwitz et al is cited on the 6,403,183 as prior art. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the compositions of 6,403,183 for treatment of the fiber and paper food packaging as an prior art recognized substrate used in food packaging.

Conclusion


18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM
March 10, 2003